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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/060,124

01/28/2002

Jeffrey S. Pickering

DAO101

5907

20482

7590

05/03/2004

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EXAMINER

RADA, ALEX P

ART UNIT

PAPER NUMBER

3714

9

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,124

Applicant(s)

PICKERING ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to the amendment filed February 9, 2004 in which the applicant cancels claims 2-4 and 7-9, amends claims 1, 5, and 6, adds new claims 10-17, and claims 1, 5-6, and 10-17 are pending in this office action.

1. The affidavit under 37 CFR 1.132 filed February 9, 2004 is insufficient to overcome the rejection of claims 1-9 based upon the Play Dao website and the article review from Abstract Games Magazine, which was available on the Play Dao website as set forth in the last Office action because: The affidavit does not provide any evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, and invention before the date of the reference does traverse the rejection in the previous office action (see MPEP 716). The affidavit submitted seems to be a mere opinion of the applicant without any factual evidence. The examiner notes that the website was established and placed on line in December of 1999, but without any information. What was on the Play Dao website when it was established? What if any, information was on the website?

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations in claims 5, 12, 13, 17, and the method of claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 12, 13, 16, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure does not provide all of the limitations disclosed in claims 12, 13, 16, and 17. The examiner request applicant to point out in the disclosure the claimed limitations. Applicant is reminded that no new matter may be entered.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 5, 10-15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 1, 5, 10-15, and 17 the preamble recites a "game" yet both apparatus and method claims appear to be in the body of the claim, which leads to wonder if applicant is claiming an apparatus or a method.

In claims 12-13 and 17 the preamble recites a "game" yet a program appears to be in the body of the claims, which leads to wonder if applicant is claiming an apparatus or a program.

In claim 16 the preamble recites a "method" yet a program appears to be in the body of the claim, which leads to wonder if applicant is claiming a method or program.

The function of the program noted above does not provide the function to be limiting to the structure and should applicant desire function to be limiting of structure, 35 U.S.C. 112 6th Paragraph language should be invoked.

Claim 10 recites the limitation "the edges" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 5-6, and 10-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Play Dao website.

9. The Play Dao website discloses a board game having the following:

A surface with a playing area having sixteen playing positions arranged in a four-by-four grid, eight playing pieces in two sets of four, each of the sets distinguishable from the other, and rules of the game (about Dao page) as recited in claim 1.

The game additionally having printed matter setting forth a method of play therefore, and the method of play is the rules of the game as recited in claim 5.

The game having additionally printed matter setting forth a method of play therefor, and the method of play is the rules of the game (about Dao page) as recited in claim 5.

The game board method having the following:

Providing a playing area having sixteen playing positions arranged in a four-by-four grid,

providing eight playing pieces in two sets of four, each of the sets distinguishable from the other,

assigning one of the sets of playing pieces to a player,

assigning the other set of playing pieces to a different player,

placing the playing pieces on the playing area in an X-shaped configuration such that each set of playing pieces is aligned diagonally on the playing area to form a strait line between two corners of the playing area,

selecting a first player, who begins play by moving one of the playing pieces assigned to that player from the starting configuration to any one of the playing positions, subject to the provision that in completing a move, the move must in a straight line, and the playing pieces must be moved as far as possible until the one of the playing pieces reaches the end of the playing area or another of the playing pieces, and further

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subject to the provision that in completing the move, the playing pieces cannot be moved over another of the playing pieces or to one of the playing positions that is already occupied by another of the playing pieces,

selecting a second player who continues play by moving one of the playing pieces assigned to that player subject to the same conditions of the move of the first player,

continuing play during which the first player and the second player, in alternating turns, make moves until one player is declared the winner, and

declaring the winner to be the player who aligns his or her playing pieces to:

form any straight line except a diagonal line,

occupy all of the playing positions in the corners of the playing surface at the same time,

form a square configuration with all of the winner's playing pieces adjacent to each other, or

have any one of the winner's playing piece blocked in any one of the playing positions at the corners of the playing surface by three of the playing pieces of the other player as recited in claim 6.

The playing pieces can be moved in strait lines the are parallel to the edges of the playing area and the playing pieces can also be moved in strait lines that are diagonal to the edges of the playing area as recited in claim 10.

A set of playing pieces is in a winning configuration if it satisfies any one of the conditions from the group of conditions consisting of:

All of the playing pieces in a set from a non-diagonal strait line on the playing area, all of the playing pieces in a set being located in the corner playing positions of the

playing area at the same time, and all of the playing pieces in a set being adjacent to each other such that the set of playing pieces forms a square as recited in claim 11.

A computer having a visual display device and a user input device programmed such that the playing area and playing pieces are displayed on the display device, a user can use the input device to designate a playing piece for movement and designate a playing area that the piece is to be moved to, the computer will change the displayed location of the playing pieces based on the user input, the computer will keep track of the location of the playing pieces, the computer will not allow a playing piece from either set to be moved out of turn and moved to any playing position other than the last open playing position along a straight line from the playing position occupied by the playing piece that is being moved, the computer will display a signal when a set of playing pieces is in a winning configuration and the computer will return the displayed playing pieces to the starting configuration based on user input as recited in claim 12.

A user can use the input device to control the movement of one set of playing pieces and the computer will move the other set of playing pieces as recited in claim 13.

The playing area is located on a portable playing surface as recited in claim 14.

A playing area having sixteen playing positions arranged in a four-by-four grid, eight playing pieces in two sets of four, each of the sets distinguishable from the other, printed matter setting forth the rules of the game and a method of play therefore, the playing pieces on the playing area in an X-shaped configuration such that each set of playing pieces is aligned diagonally on the playing area to form a straight line between two corners of the playing area, one playing piece from one of the sets is then moved in a

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strait line to the furthest playing position along that strait line that is not occupied by another playing piece, one playing piece from the other set is then moved in a strait line to the furthest playing position along that strait line that is not occupied by another playing piece, and playing continues with moves in a strait line alternating between the two sets of playing pieces until one of the sets of playing pieces is configured such that it stratifies any one of the conditions from the group of the conditions consisting of;

- all of the playing pieces in a set forming a non-diagonal strait line on the playing area,

- all of the playing pieces in a set being located in the corner playing position of the playing area at the same time,

- all of the playing pieces in a set being adjacent to each other such that the set of playing pieces forms a square, and

- all of the playing pieces in a set being located in any corner playing position and being blocked from movement in any direction by three playing pieces from the other set as recited in claim 15.

The game is played using a computer having a visual display device and a user input device programmed with suitable algorithms such that, the playing area and playing pieces are displayed on the visual display device,

- a user can use the input device to designate a playing piece for movement and designate a playing area that the piece is to be moved,

- the computer will change the displayed location of the playing pieces based on the user input,

- the computer will keep track of the location of the playing pieces,

the computer will not allow a playing piece from either set to be moved out of turn, the computer will not allow a playing piece from either set to be moved to any playing position other than the last open playing position along a straight line from the playing position occupied by the playing piece that is being moved,

the computer will display a signal when a set of playing pieces is in a winning configuration, and

the computer will return the displayed playing pieces to the starting configuration based on user input as recited in claim 16.

A user can use the input device to control the movement of one set of playing pieces and the computer will move the other set of playing pieces as recited in claim 17.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kerry Handscomb, review from Abstract Games Magazine (copyright from play Dao website 1999).

11. The review from Abstract Games Magazine discloses a board game having the following:

A playing area having sixteen playing positions arranged in a four-by-four grid, eight playing pieces in two sets of four, each of the sets distinguishable from the other, and rules of the game as recited in claim 1.

In regard to the claimed (rules of the game) in claim 1, these statements are considered to be game rules. In game apparatus claims, only the claimed elements having physical structure (e.g. eight playing pieces, a playing area having sixteen playing positions) are given patentable weight. Game rules, (e.g. the playing pieces arranged in an X-shaped configuration, one playing area to form a straight line between two corner of the playing area etc.), however, have no physical structure per se. Thus, game rules have no limiting affect in game.

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apparatus claims. Inherently, any game played would provide some types of printed matter for instructions on how to play the game.

12. Claims 1, 5, 10, 11, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamle '080.

13. Lamle discloses the following:

A board game having a playing are having sixteen playing positions arranged in four-by-four grid (figures 1 and 8), eight playing pieces in two sets of four, in which the examiner interprets the Lamie reference to have the equivalent to the claimed eight playing pieces in two sets of four, each of the sets distinguishable from the other (squares and circles) and rules of the game as recited in claim 1.

The playing pieces can be moved in strait lines the are parallel to the edges of the playing area and the playing pieces can also be moved in strait lines that are diagonal to the edges of the playing area as recited in claim 10.

A set of playing pieces is in a winning configuration if it satisfies any one of the conditions from the group of conditions consisting of:

All of the playing pieces in a set from a non-diagonal strait line on the playing area (figures 3 and 4), all of the playing pieces in a set being located in the corner playing positions of the playing area at the same time (figure 6), and all of the playing pieces in a set being adjacent tot each other such that the set of playing pieces forms a square (figure 7) as recited in claim 11.

The playing are is located on a portable playing surface as recited in claim 14.

In regard to the claimed (rules of the game) in claim 1, these statements are considered to be game rules. In game apparatus claims, only the claimed elements having physical structure

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(e.g. eight playing pieces, a playing area having sixteen playing positions) are given patentable weight. Game rules, (e.g. the playing pieces arranged in an X-shaped configuration, one playing area to form a strait line between two corner of the playing area etc.), however, have no physical structure per se. Thus, game rules have no limiting affect in game apparatus claims. Inherently, in claim 5, any game played would provide some types of instructions on how to play the game.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 12-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamle '080 in view of Harris '372.

16. Lamle discloses the claimed invention as discussed above except for the following:

A computer having a visual display device and a user input device programmed such that the playing area and playing pieces are displayed on the display device, a user can use the input device to designate a playing piece for movement and designate a playing area that the pieces is to be moved to, the computer will change the displayed location of the playing pieces based on the user input, the computer will keep track of the location of the playing pieces, the computer will not allowing a playing piece from either set to be moved out of turn and moved to any playing position other than the last open playing position along a strait line from the playing position occupied by the

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playing piece that is being moved, the computer will display a signal when a set of playing pieces is in a winning configuration and the computer will return the displayed playing pieces to the starting configuration based on user input as recited in claim 12.

A user can use the input device to control the movement of one set of playing pieces and the computer will move the other set of playing pieces as recited in claim 13.

A user can use the input device to control the movement of one set of playing pieces and the computer will move the other set of playing pieces as recited in claim 17.

Harris teaches a game having visually displayed on the computer with a program that assigns different program actions to rules for a game. By having a game played on a computer, one of ordinary skill in the art would provide a new and improved game. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Lamle to include a program that assigns different program actions to rules for a game as taught by Harris to provide a new and improved game.

Response to Arguments

17. Applicant's arguments with respect to claims 1, 5-6, and 10-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JESSICA HARRISON
PRIMARY EXAMINER